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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/583,220

06/16/2006

Atsushi Miyazaki

JFE-06-1129

7655

35811

7590

03/31/2009

IP GROUP OF DLA PIPER US LLP

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PHILADELPHIA, PA 19103

EXAMINER

FOGARTY, CAITLIN ANNE

ART UNIT

PAPER NUMBER

1793

MAIL DATE

DELIVERY MODE

03/31/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Advisory Action
Before the Filing of an Appeal Brief

Application No.

10/583,220

Applicant(s)

MIYAZAKI ET AL.

Examiner

CAITLIN FOGARTY

Art Unit

1793

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 18 March 2009 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: _____.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

/Roy King/
Supervisory Patent Examiner, Art Unit 1793

Continuation of 11, does NOT place the application in condition for allowance because: the arguments filed 3/18/2009 are not persuasive. Therefore, the 35 U.S.C. 103(a) rejection and the provisional nonstatutory obviousness-type double patenting rejection set forth in the 12/23/2008 Office action are maintained.

Applicant argued that Kawabata did not seek or even recognize the issues associated with achieving low thermal expansion coefficients for corrosion-resistant steels in applications in which heat cycles are frequently repeated between high and low temperatures. Thus, the emphasis in Kawabata is quite different from that and the Applicants' activities. Applicant also argues that there is nothing in Kawabata that would have led one skilled in the art to have any appreciation for the impact of W on thermal expansion coefficient, much less a prescribed amount of W precipitate. Thus, the relationship between the amount of precipitated W and thermal expansion coefficient is not described at all in Kawabata. Finally, Applicant also argued that there is an important difference between the Kawabata process and the Applicants' process. The finish annealing step in Kawabata is performed for 10 seconds whereas the annealing step in the instant invention is measured in minutes. Both Kawabata and the Applicants' steel sheets are thin and the impact of annealing based on a ten second exposure versus a three minute exposure can be profound.

In response to Applicants arguments, Kawabata is not required to teach the same benefits or to solve the same problem as the instant invention. See MPEP 2144 IV. Therefore, the Examiner maintains the rejection set forth in the 12/23/2008 Office action that since the composition of the ferritic-Cr-contained steel of Kawabata overlaps with the composition of the steel of the instant invention and since the steel of Kawabata is made using a method similar to the method of the instant invention, one of ordinary skill in the art would expect the steel of Kawabata to inherently have a similar amount of precipitated W and a similar average thermal expansion coefficient between 20 and 800 degrees C. See MPEP 2112. Furthermore, Applicant has not submitted factual evidence to support the argument that a similar amount of precipitated W and a similar average thermal expansion coefficient between 20 and 800 degrees C would not be inherent in the ferritic Cr-contained steel of Kawabata. In addition, Applicant has not submitted factual evidence to show that the final annealing time would have an impact on the final properties of the steel.